

REMARKS

The Official Action mailed April 17, 2003, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to August 17, 2003. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on November 15, 2001 and September 20, 2002.

Claims 1-28 are now pending in the present application, of which claims 1-5, 24 and 27 are independent. Independent claims 24 and 27 have been amended to better recite the features of the present invention. Claims 2-6 and 24-28 have been amended to correct minor typographical and grammatical errors. The Applicant notes with appreciation the allowance of claims 2-5, 7-18 and 20-23. For the reasons set forth in detail below, all claims are believed to be in condition for allowance.

Paragraph 2 of the Official Action rejects claims 1, 6, 24 and 25 as anticipated by JP 62-274729 to Katami. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present invention. Katami does not teach all the elements of the independent claims, either explicitly or inherently.

With respect to independent claim 1, Katami does not teach a first mask and a second mask, where the second mask is formed to cover a portion of a lower layer of an interlayer insulator, which is exposed by an etching step using the first mask. It appears that the Official Action relies on layer 107 in Katami to teach both a first mask and a second mask. The Applicant respectfully submits that layer 107 in Katami may not be both a first mask and a second mask, especially in the present case where the second mask is formed to cover a portion of a lower layer of an interlayer insulator, which is exposed by an etching step using the first mask.

Independent claims 24 and 27 have been amended to recite that a semiconductor comprises at least one thin film transistor and that a second interlayer insulating film is at least five times thicker than a first interlayer insulating film. The feature of "at least one thin film transistor" is recited in allowed claims 2-5. Film thicknesses are discussed at page 12, lines 8-11 of the specification which, for

example, discloses "silicon oxide film [first interlayer insulating film] having the thickness of 300 Å and silicon nitride film [second interlayer insulating film] having the thickness of 4700 Å." Katami does not teach film thicknesses of interlayer insulating films and Figs. 1A to 1E of Katami show that the first interlayer insulating film 105 is thicker than the second interlayer insulating film 106.

Since Katami does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are in order and respectfully requested.


Paragraph 4 of the Official Action rejects claims 19 and 26-28 as obvious based on the combination of Katami and U.S. Patent No. 5,063,378 to Roach. Also, paragraph 5 of the Official Action rejects independent claim 27 as obvious based on Katami. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present invention.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Roach does not cure the deficiencies in Katami noted above. The Official Action relies on Roach to allegedly teach etching contact vias through a silicon oxide/silicon nitride insulation layer and through an extended gate oxide layer (pages 4-7). Katami and Roach, either alone or in combination, do not teach or suggest either a first mask and a second mask, where the second mask is formed to cover a portion of a lower layer of an interlayer insulator, which is exposed by an etching step using the first mask (independent claim 1), or that a semiconductor comprises at least one thin film transistor and that a second interlayer insulating film is at least five times thicker than a first interlayer insulating film (independent claims 24 and 27, as amended). Since Katami and Roach do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789